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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,922	06/26/2001	Bret P. O'Rourke	MS1-656US	3848

22801 7590 08/03/2005

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EXAMINER

AL HASHEMI, SANA A

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,922

Applicant(s)

O'ROURKE ET AL.

Examiner

Sana Al-Hashemi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-23 is/are allowed.
- 6) ☒ Claim(s) 1-9 and 24-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is issued in response to applicant's request for reconsideration filed 7/29/05.
2. Claims 1-34 are pending. No claims were added. None were canceled.
3. Applicant's arguments with respect to claims 1-34 have been considered but are moot in view of the new ground(s) of rejection.
4. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter.

Claims 32-34 are rejected under 35 U.S.C. 101 because none of the independent claims in conjunction with all dependent claims are statutory.

The claimed invention is directed to non-statutory subject matter. Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101. Thus, Office personnel should consider the claimed invention as a whole to determine whether the necessary functional interrelationship is provided. Where certain types of descriptive material, such as music, literature, art, photographs

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and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such "descriptive material" is not a process, machine, manufacture or composition of matter. (Data consists of facts, which become information when they are seen in context and convey meaning to people. Computers process data without any understanding of what that data represents. Computer Dictionary 210 (Microsoft Press, 2d ed. 1994).) The policy that precludes the patenting of nonfunctional descriptive material would be easily frustrated if the same descriptive material could be patented when claimed as an article of manufacture. For example, music is commonly sold to consumers in the format of a compact disc. In such cases, the known compact disc acts as nothing more than a carrier for nonfunctional descriptive material. The purely nonfunctional descriptive material cannot alone provide the practical application for the manufacture. Office personnel should be prudent in applying the foregoing guidance. Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101. The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that recognizes a particular grouping of musical notes read from memory and upon recognizing that particular sequence, causes another defined series of notes to be played, defines a functional

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interrelationship among that data and the computing processes performed when utilizing that data, and as such is statutory because it implements a statutory process.

The claimed subject matter in the instant application is directed to a nonfunctional descriptive material (music, literature, art, photographs and mere arrangements of compilations of facts or data are merely stored) and since the data structure is non-interactive “descriptive material per se. As such, the claimed subject matter is not statutory and not eligible for patent protection.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-9, 24-31, are rejected under 35 U.S.C. 102(e) as being anticipated by Eyal (US Patent No. 6,484,199).

Regarding Claims 1, and 24, Eyal discloses a method for a server to provide content to a client, the method comprising:

receiving a request from the client for one or more requested content items (Col. 2, lines 63-67, Eyal);

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identifying a data structure that refers to one or more further content items (Col. 4, lines 2-5, Eyal) ;

modifying, by the server computer, a data structure that refers to one or more further content items (Col. 3, lines 5-11, Eyal, wherein the step of modifying by the server, a data structure is inherently in each server since the server has to convert the data from a digital form to a readable form this is way of modifying the data structure); and

providing the content items referenced by the modified data structure (Col. 3, lines 12-15, Eyal);

Regarding Claims 2, and 25, Eyal discloses a method wherein identifying the data structure, the data structure comprises a playlist (Col. 6, lines 60-63, Eyal);

wherein receiving the request, the one or more requested content items comprises streaming media content (Col. 9, lines 5-12, Eyal); and

wherein providing the content items further comprises streaming the content items referred to by the playlist (Col. 9, lines 13-21, Eyal).

Regarding Claims 3, and 26, Eyal discloses a method wherein identifying the data structure, the data structure comprises a first Web page specification, and the requested content comprises a second Web page specification (Col. 9, lines 48-55, Eyal).

Regarding Claims 4, and 27, Eyal discloses a method wherein modifying the data structure further comprises adding a plurality of references to the requested content item in the data structure (Col. 12, lines 57-63, Eyal).

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Regarding Claims 5, and 28, Eyal discloses a method wherein modifying the data structure further comprises adding a plural number of references to the requested content item in the data structure, the number being indicated by the request (Col. 12, lines 57-63, Eyal).

Regarding Claim 6, Eyal discloses a method wherein receiving the request, further comprises receiving a variety of requests from the client, at least one subset of the variety of requests comprising respective requests to one or more different content items (Col. 9, lines 27-31, Eyal).

Regarding Claim 7, Eyal discloses a method wherein modifying the data structure, the data structure further comprises a placeholder that identifies a particular point in a sequence where the reference to the requested content is placed (Col. 9, lines 34-39, Eyal).

Regarding Claims 8, and 29, Eyal discloses a method wherein identifying the data structure further comprises creating the data structure by modifying a base data structure (Col. 12, lines 38-46, Eyal).

Regarding Claims 9, and 30, Eyal discloses a method wherein identifying the data structure further comprises creating the data structure copying a base data structure (Col. 12, lines 38-46, Eyal).

Regarding Claim 31, Eyal discloses sever wherein at least a subset of the received request refer to differing content items (Col. 12, lines 19-27, Eyal).

Allowable Subject Matter

Claims 10-23 allowed.

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The following is an examiner's statement of reasons for allowance: regarding independent claim10, the prior art fails to teach or suggest the steps providing streaming media content to a plurality of clients, the computer program instructions comprising instructions for: receiving a request that refers to one or more streaming media content items; identifying a playlist that refers to a sequence of one or more further streaming media content items; modifying the playlist to reference the one or more requested streaming media content items in the sequence; and streaming the streaming media content items referenced by the modified playlist., in conjunction with remaining claim provisions.

The following is an examiner's statement of reasons for allowance: regarding independent claim17, the prior art fails to teach or suggest the steps providing Web content to a plurality of clients, the computer program instructions comprising instructions for: receiving a request from the client for one or more requested Web documents; identifying a wrapper Web document that refers to one or more further Web documents; modifying the wrapper Web document to reference the one or more requested Web documents; and providing the Web documents referenced by the modified wrapper Web document to the client., in conjunction with remaining claim provisions.

The dependent claims 11-16, and 18-23, being further limiting to the independent claims, definite and enabled by the Specification are also allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

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fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Comments

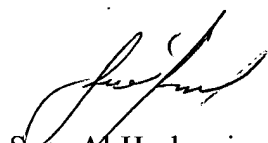
The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply outside the SIX (6) MONTH statutory period or obtain an extension for more than FIVE (5) MONTHS beyond the date for reply set forth in an Office action. A fully responsive reply must be timely filed to avoid abandonment of this application.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Points of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sana Al-Hashemi whose telephone number is (571) 272-4013. The examiner can normally be reached on 8Am-4:30 Pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sana Al-Hashemi
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Technology Center 2100
August 1, 2005